

1. (Amended) A vaccine comprising an immunogen capable of eliciting an immune response protective against infection by feline immunodeficiency virus (FIV) when administered in an effective amount to a susceptible host, wherein the immunogen provides immunological protection against FIV.

2. (Amended) A vaccine [composition] as in claim 1, further comprising an adjuvant.

3. (Amended) A method for protecting a cat against FIV infection, said method comprising administering to said cat an effective dose of a vaccine comprising an immunogen [immogen] capable of eliciting an immune response protective against infection by FIV.

#### REMARKS

Claims 1-3 are pending. Claims 1-3 were rejected on both formal and substantive grounds. Claims 1-3 have been amended. Reexamination and reconsideration of all pending claims as amended are respectfully requested.

#### I. Incorporation by Reference.

The Examiner has objected to the incorporation of "essential material" by reference, particularly to the incorporation of three issued patents on page 21 of the specification. Such objection is respectfully traversed. The patents referred to relate generally to forming viral vaccines, and the teachings are not considered to be essential to the present application. Rather, they provide useful background and demonstrate that the preparation of viral vaccines, in general, is known. The MPEP defines essential material as relating to the "essential novelty, the essence of the invention." MPEP

§608.01(p). The essential novelty of the present invention relates to vaccines for the treatment of FIV not the preparation of viral vaccines in general.

For the reasons, Applicants respectfully request that the objection to the incorporated material be withdrawn.

II. Informalities in the Specification

The informalities noted by the Examiner in the Specification have been corrected.

III. Obviousness-type Double Patenting

Applicants will submit a suitable Terminal Disclaimer at an appropriate point during prosecution.

IV. Rejections Under 35 USC §112, First Paragraph

The Examiner has rejected claims 1 and 3 as being enabled "only for claims limited to vaccines comprising immunogens that provide immunological protection against FIV." Such rejection has been overcome by amending claim 1 to limit claim 1 to such immunogens.

V. Rejections Under 35 USC §112, Second Paragraph

Claim 2 has been amended to correct the lack of antecedent basis noted by the Examiner.

VI. Rejections Under 35 USC §102 and 103

As a first initial matter, Applicants respectfully submit that use of the designation of Feline Immunodeficiency Virus or "FIV" does not constitute "new matter" relative to the earlier line of cases stemming from USSN 07/089,700, filed in August 1987. That earlier application utilized the old terminology Feline T-Lymphotropic Virus or FTLV. This new application substituted the old FTLV terminology for the now accepted FIV designation. As the CAFC made clear in *In re Lundak*

227 USPQ 90 (CAFC 1985), a new matter rejection is not appropriate merely because a specification as filed lacks certain language at the time of filing. In *Lundak* an application was filed without providing data relating to the deposit of a micro-organism. The CAFC held that such information could be inserted into the specification later and would not comprise new matter. The present situation is analogous. The earlier filed applications related to the virus then known as FTLV. Substitution of the now commonly accepted FIV designation in no way comprises new matter.

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As a second initial matter, Applicants believe that the Examiner has failed to appreciate that the present application is a continuation of USSN 07/995,304, filed on December 21, 1992, which was a continuation of USSN 07/<sup>726 061</sup>~~226,061~~, filed on July 5, 1991. The text of the Specification of the present application is identical to that filed in USSN <sup>07/726 061</sup>~~08/226,061~~. Thus, the present application is entitled at least to the filing date of July 5, 1991. Applicants further believe that the present application is entitled to the filing date of USSN 07/089,700 in the other chain of previous applications, but establishing that earlier filing date is not necessary to address the art rejections presently raised by the Examiner.

Claims 1-3 were rejected under 35 USC §102(b) as being anticipated by or, in the alternative under 35 USC §103 as obvious over Petersen et al. '753 or '602, Hohdatsu et al., or Yamamoto et al. These rejections must fail in view of the clear entitlement of the present application to a filing date of July 5, 1991.

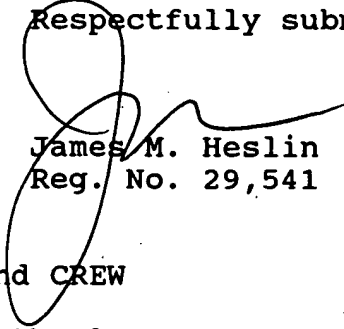
In view of the above amendments and remarks, Applicants believe that all claims of the present application are now in condition for allowance and request that the application be passed to issue at an early date.

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If the Examiner believes a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at (415) 326-2400.

Respectfully submitted,



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